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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,274	03/27/2001	Wayne Edward Beimesch	390780	6754

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EXAMINER

ROGERS, DAVID A

ART UNIT

PAPER NUMBER

2856

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,274

Applicant(s)

BEIMESCH, WAYNE EDWARD

Examiner

David A. Rogers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, as amended, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,140,845 to Robbins. Robbins clearly discloses a method to test for volatile organic compounds (VOCs) using both a sealable bag (reference item 120) to store a material and a flame ionization detector (FID) to perform the tests (column 3, lines 67-68). Robbins discloses that storage tanks are a source of VOCs (column 1, lines 16-20). With regard to claims 1 and 7 Robbins discloses that it is beneficial to store the bag at an optimum temperature in order that the headspace reach a state of equilibrium (column 5, lines 1-6). With regard to claim 4 Robbins discloses that time is a relevant factor to reach the desired equilibrium in the headspace (column 4, lines 57-58). With regard to claim 5 Robbins discloses that the initial mass of the sample is directly related to the measured equilibrium headspace concentration (equation 5, equation 7).
3. Robbins discloses the claimed invention except for the recitation of material storage for 5-24 hours, initial material mass of 1-100 grams, and a temperature range from 5° C-100° C. It is well known in the art that temperature affects the mass transfer coefficient, and, therefore, equilibrium of the headspace. One of ordinary skill in the art would be highly motivated to ensure that the material is subjected to its expected operating conditions in order to accurately determine if VOCs are being released. The range limitations recited represent optimum ranges

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in order to reach headspace equilibrium and would be determined on a case-by-case basis for the material being tested. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. See *In re Aller*, 105 USPQ 233.

4. The applicant intends to distinguish the instant application from a method to test for VOCs using the device of Robbins based on the sole criteria that the method claimed includes, indirectly, the step of collecting the material to be tested from a process system. The applicant defines a process system as a spray dryer, mixer, fluid bed dryers and coolers, and storage tanks. Robbins, as noted above, tests material that may have been exposed to VOCs from leaks in storage tanks. One of ordinary skill in the art would clearly recognize that if the material in the storage tank has VOCs, then so would any material exposed to leaks from the tank. Furthermore, the instant application utilizes a resealable polyethylene bag in order to contain the material to be tested. This is the same type of bag used in the device and method of Robbins. Clearly if a polyethylene bag is used to test the material in the instant application, then the method to use the bag of Robbins would clearly be applicable to the claimed method of the instant application. One of ordinary skill in the art would clearly recognize and understand that the method to use the bag to contain a sample or material containing VOCs is not dependent on the source of the material. That is, any material, either from the ground or from some other system or facility, can be placed in the bag of Robbins and tested for VOCs. Finally, the applicant has not provided specific methodology steps to collect the VOC-containing material for placement in a polyethylene bag that are both dependent on the source of the VOC-containing material and provides for a new, novel, or otherwise unexpected result over the method to use the

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device of Robbins. That is, the applicant does not disclose or claim how collecting VOC-containing material from a process system differs from the collecting VOC-containing material of the method of Robbins. Since it is widely known that VOCs may be a substantial health and environmental hazard, it would have been obvious to one of ordinary skill in the art that material suspected of containing VOCs, despite its source, should be tested for VOCs. In this regard, the method to use the device of Robbins would clearly be applicable to any material source. The source of the material does not provide for unobvious or unexpected result over a method to use the device of Robbins. Furthermore, it has been held that to be entitled to weight in a method claim the recited structure limitations therein must affect the method in a manipulative sense. They cannot amount to the mere claiming of a use of a particular structure. See *Ex parte Pfeiffer*, 135 USPQ 35 (1961).

5. Claims 8-10, as amended, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,930,906 to Hemphill. Applicant's intended use, that being for holding VOC-containing material from a process system, has not been given any patentable weight. The applicant claims a kit comprising a bag that can be sealed and instructions. This is clearly anticipated by the device of Hemphill where a resealable bag (reference item 10) has instructions (reference items 18 and 20). One of ordinary skill in the art would be highly motivated to ensure that appropriate instructions related to the intended use of the bag would be included as a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Hemphill to obtain a resealable bag with instructions to store and test the VOC-containing material.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Rogers whose telephone number is (703) 305-4451.

The examiner can normally be reached on Monday - Friday (0730 - 1600).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on (703) 305-4705. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

dar 
September 19, 2002


HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800